Remarks

This amendment is submitted in response to the Office Action mailed 30 May 2006, in connection with the above-identified application (hereinafter, the "Office Action"). The Office Action provided a three-month shortened statutory period in which to respond, ending on 30 August 2006. Submitted herewith is a Petition for a Two-Month Extension of Time extending the due date to 30 October 2006. Accordingly, this amendment is timely submitted.

The Applicant has fully considered the Office Action and cited references and submits this Reply and Amendment in response to the outstanding rejections. Reconsideration of the application for patent is requested. Applicants do not acquiesce in the correctness of the rejections or objections and reserve the right to present specific arguments regarding any rejected or objected-to claims not specifically addressed. Further Applicants reserve the right to pursue the full scope of the subject matter of the claims in a subsequent patent application that claims priority to the instant application.

Claims 1 through 8 and 10 through 24 are currently pending. Applicant respectfully requests the cancellation of claim 23 without prejudice.

Claims rejections under 35-USC §112

The Examiner has rejected claims 1-8 and 10-24 under 35-USC §112, first paragraph. In regards to claim 1, as a part of a combination, whey protein hydrosylate is required. In regards to claim 10, Applicant believes that one of ordinary skill in the art would understand the claim to mean that whey protein hydrosylate comprises from a very small amount, up to a maximum of about 20% of the combination of whey protein isolate and whey protein hydrolysate. Claim 23 is herein cancelled without prejudice which renders this rejection moot. For the reasons stated above, the Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claims rejections under 35-USC §103

The Examiner has rejected Claims 1-8, 10-20 and 22-24 under 35 USC §103 Liebrecht in view of Burke (GB 2335134A). As admitted by the Examiner, Liebrecht does not disclose the use of whey protein hydrosylates, further Applicant does not know what "as being unpatentable over Liebrecht et al as applied above" refers to (page 2, section 5). This is the first mention of Liebrecht in this Office Action.

Applicants respectfully submit that this rejection is improper because a prima facie case of obviousness has not been established. The three elements of a prima facie case of obviousness are: 1) some suggestion or motivation to modify the reference or combine the teachings; 2) a reasonable expectation of success and 3) the prior art references must teach or suggest all the claim limitations. Fine 837 F.2d 1071 (Fed.Cir 1988), In re Jones 958 F.2d 347

(Fed.Cir 1992). Burke relates to a carbonated sports drink of high caloric value people engaged in physical activities, and Liebrecht is specifically for providing calcium supplementation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990). Neither reference suggests the desirability of the combination since their intended uses are dramatically varied. The Examiner states that since both Burke and Liebrecht are nutritional beverages based on fruit juice, carbohydrate and protein. Applicant respectfully disagrees, especially in light of no suggestion in either reference of the desirability of the combination. Applicant submits there is no suggestion or motivation in Burke or Liebrecht to modify the reference or combine the teachings. "Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making" the necessary modification. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051 5 U.S.P.Q.2d 1434, 1438 (Fed Cir.), cert denied, 488 U.S. 825 (1988)

Turning now to the second element of obviousness, there is no reasonable expectation of success. Contrary to a reasonable expectation of success, Burke states that protein hydrosylates have a problem that they tend to precipitate (page 3, lines 22-28), and thus need specific levels of specific carbohydrates to prevent this precipitation. Further in the present application in paragraph 5 it describes that "The development of fruit juice based beverages containing proteins, carbohydrates, vitamins, and minerals is very difficult. The interaction of the ingredients, particularly the protein with the minerals and other ingredients, often cause the protein to precipitate and frequently cause the entire composition to become very viscous or to gel. Similarly, these interactions may change the physical or chemical properties of the composition in a way that adversely affects the taste, color, odor, mouth-feel and other physical properties of the composition. These adverse changes may occur at any time but are particularly likely when the composition is heated during processing or when the composition sits on the shelf for extended periods. The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. In re Merck & Co., Inc., 231 USPQ 375 (Fed. Cir. 1986); MPEP 2143.02, in this case there is no reasonable expectation of success. Neither reference teaches or suggests that the addition of protein hydrosylates will illicit a clear beverage and not cause the problems of precipitation when added to a composition as described in the present invention.

In the present Office Action the Examiner has asserted that this element is addressed in Burke at page 3, line 28, however, page 3, line 28 does not address the combination of Burke and Liebrecht, which, as argued above would likely cause the protein to precipitate and not render a clear composition.

In the present Office Action the Examiner has asserted that this element (a clear beverage and not cause the problems of precipitation) is addressed in Liebrecht at column 1, line 7, however, column 1, line 7 does not address the combination of Burke and Liebrecht,

which, as argued above would likely cause the protein to precipitate and not render a clear composition.

Even if Liebrecht and Burke were to be combined, the solution proposed by Applicant would not be achieved since they still would not teach how to combine the ratio of ingredients claimed in Claim 1, nor a clear, palatable beverage, without precipitate of the protein.

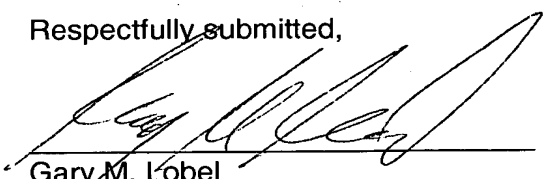
The Examiner has rejected Claim 21 under 35 USC §103 Liebrecht in view of Burke, in view of Harado (JP 404311378A). There is no motivation to combine Liebrecht, Burke and Harado since Liebrecht is specifically for providing calcium supplementation, Burke is specifically a high calorie sports drink and Harado deals with fiber supplementation. Each designed to address very different issues. There must be a teaching in the prior art for the proposed combination or modification to be proper. In re Newell, 13 U.S.P.Q.2d 1248 (Fed Cir. 1989). There is no such teaching or suggestion in Liebrecht, Burke or Harado, to combine these references.

Applicant submits that even if the skilled person were to combine the teaching of Liebrecht, Burke and Harado, the solution proposed by Applicant would not be achieved. As described above regarding paragraph 5, that "The development of fruit juice based beverages containing proteins, carbohydrates, vitamins, and minerals is very difficult. The interaction of the ingredients, particularly the protein with the minerals and other ingredients, often cause the protein to precipitate and frequently cause the entire composition to become very viscous or to gel." Therefore, the combined references would not teach or suggest how to make a clear, palatable beverage, without precipitate of the protein.

Thus, in view of the foregoing arguments, Applicant respectfully requests that these rejections under 35 U.S.C. §103 be withdrawn.

Applicant respectfully requests reconsideration of the present application. If a telephone interview would be of assistance in advancing the prosecution of the application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Respectfully submitted,



Gary M. Lobel
Attorney for Applicants
Reg. No. 51,155

Novartis
Corporate Intellectual Property
One Health Plaza, Building 430
East Hanover, NJ 07936-1080
(862) 778-7954

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